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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,983	01/30/2001	Junichi Hayashi	35.C15073	9440
5514	7590	12/13/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			COUSO, YON JUNG	
			ART UNIT	PAPER NUMBER
			2625	
DATE MAILED: 12/13/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/771,983

Applicant(s)

HAYASHI ET AL.

Examiner

Yon Couso

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 15-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 24-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2625

1. Applicant's arguments with respect to claims 1-14 and 24-36 have been considered but are moot in view of the new ground(s) of rejection.
2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14 and 24-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads (US 6,122,403).

Regarding claim 1, Rhoads discloses a digital watermarking system for linking computer system using the information in data objects comprising the steps of: a first information extraction step of extracting information including a registration signal, including a registration signal used to correct the geometrical distortion of an image (at least at column 83, lines 37-63); and a determining step of employing the results obtained at the first information extraction step to determine whether a process for extracting digital watermark information from the image is to be performed (at least at column 83, line 64-column 84, line 32).

As to claim 2, Rhoads discloses the first information and the second information are embedded in the image as invisible or less visible electronic watermarks (at least at column 71, lines 1-35).

As to claim 3, Rhoads disclose the division step for dividing the image and selection step for selecting the block (at least in figures 21A and 21B).

As to claims 4-5, Rhoads discloses the first information indicates the image includes a specific image (at least at column 29, line 61 through column 30, line 60).

As to claims 6-8, Rhoads discloses the first and second information being added to components of the image that are easily discerned by a human's eyes to identify paper currency, securities or a copyrighted image (at least at column 59, lines 10-65). Additionally, such watermarking systems are routinely used for paper currency and copyrighted material as being also disclosed by Cox (see at least at column 1, lines 8-60) and other prior art made of record in the instant application.

As to claim 9, Rhoads discloses a determination step of determining whether the specific image is included; an image process is performed based on the image (at least at column 20, lines 6-44).

As to claims 11-14, Rhoads discloses the first information is smaller than the second information, requires shorter time than the first and present in the greater area (at least in figure 18, elements 852 and 864, figure 27A and figure 42).

As to claims 24-34 and 36, claims 24-34 and 36 recite substantially very similar limitations as that of claims 1-9 and 11-14 and are similarly analyzed.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 10 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads (US 6,122,403) in view of Horigane (US 6,334,721).

Regarding claims 10 and 35, while Rhoads discloses the use of printers and scanners (at least at column 10, lines 5-50) without specific details regarding the method of claim 1 being performed by printer driver.

In the same field of endeavor, however, Horigane discloses a printing system wherein the method of claim 1 is being performed by a printed driver (at least at column 5, lines 10-45 and column 8, lines 41-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the printer driver as taught by Horigane in the watermarking system of Rhoads because the printing system of Horigane enables application data to be printed out at any printer even if machine-readable code is embedded in the application data.

Art Unit: 2625

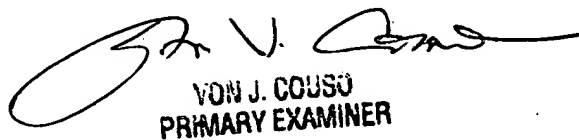
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yon Couso whose telephone number is (571) 272-7448. The examiner can normally be reached on Monday through Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta, can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YJC

December 11, 2005



YON J. COUSO
PRIMARY EXAMINER